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Clifford W Browning
Woodard Emhardt Naughton Moriarty & McNett
Bank One Center/Tower
111 Monument Circle Suite 3700
Indianapolis, IN 46204-5137

EXAMINER

MANIWANG, JOSEPH R

ART UNIT

PAPER NUMBER

2144

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,018

Applicant(s)

NICOLAS ET AL.

Examiner

Joseph R. Maniwang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☒ This action is **FINAL**, 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 1-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to under 37 CFR 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner.
2. The abstract of the disclosure is objected to because it contains numerous grammatical errors and is unclear. Correction is required. See MPEP § 608.01(b).
3. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: "consists in", "allowing to" (see Abstract), "do not use return channel towards the managing centre" (see p. 1, line 23), "others element" (see p. 2, line 29), "must satisfy the conditions of processing of the messages supposed to be received previously" (see p. 3, lines 2-4).
4. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The first paragraph of 35 U.S.C. 112 requires that the "specification shall contain a written description of the invention." "[T]he essential goal of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed." In re Barker, 559 F.2d 588, 592 n.4, 194 USPQ 470, 473 n.4 (CCPA 1977). Another objective is to put the public in possession of what the applicant claims as the invention. See Regents of the University of California v. Eli Lilly, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), cert. denied, 523 U.S. 1089 (1998). To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003). Examiner submits that the Specification as presented does not clearly describe the claimed invention with sufficient detail and in such a manner that one of ordinary skill in the art could reasonably ascertain that the disclosure actually supports the claimed invention, and thus conclude that the invention claimed was in possession of the inventor at the time of filing.

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7. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). An adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention. See, e.g., *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000). While Applicant has provided a written disclosure and accompanying figures, the level of detail supplied is inadequate and hindered by a lack of clarity in presenting evidence that the Applicant had possession of the claimed invention.

8. The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Examiner asserts that the Specification does not readily and clearly allow one of ordinary skill in the art to recognize any such invention as the one claimed by Applicant, and thus fails to meet the written description requirement set forth in the first paragraph of 35 U.S.C. 112. See MPEP § 2163.

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9. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Examiner submits that the Specification does not provide a sufficiently detailed description of how one of ordinary skill in the art could make or use the claimed invention. The requirement that the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way. The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention.

10. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. The disclosure as filed does not contain sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. Undue experimentation would be necessary in executing the invention as presently claimed as the level of detail supplied by the disclosure is inadequate in convey how to both make and use the invention to one of ordinary skill in the art. For example, the Specification provides no details describing how to "[add] to each message a conditional block which determines if [a] message is to be processed" as recited in independent claims 1 and 10. See MPEP § 2164.

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11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Regarding claims 1-15, the claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

14. Claim 1 recites the limitation "the previous processing". There is insufficient antecedent basis for this limitation in the claim.

15. Claim 3 recites the limitation "the processing state". There is insufficient antecedent basis for this limitation in the claim.

16. Claim 4 recites the limitation "the subscriber database". There is insufficient antecedent basis for this limitation in the claim.

17. Claim 5 recites the limitation "the incoming messages". There is insufficient antecedent basis for this limitation in the claim.

18. Claim 5 recites the limitation "the increasing of a stack pointer". There is insufficient antecedent basis for this limitation in the claim.

19. Claim 14 recites the limitation "the instructions received". There is insufficient antecedent basis for this limitation in the claim.

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20. Claim 15 recites the limitation "the separator of management messages". There is insufficient antecedent basis for this limitation in the claim.

21. Claim 15 recites the limitation "the processing centre". There is insufficient antecedent basis for this limitation in the claim.

22. Claim 15 recites the limitation "the subscriber module". There is insufficient antecedent basis for this limitation in the claim.

23. Claim 15 recites the limitation "the memory". There is insufficient antecedent basis for this limitation in the claim.

Response to Arguments

24. Applicant's arguments filed 10/07/05 have been fully considered but they are not persuasive.

25. Examiner acknowledges Applicant's amendments to the Oath/Declaration and Drawings in overcoming previous objections. The objections have been withdrawn.

26. Regarding the newly submitted Specification, the Specification has been reviewed and has been found to contain no new matter. However, the Specification is replete with terms and phrases which are not clear, concise, and exact. The Specification does not readily and clearly allow one of ordinary skill to make and use the invention set forth by the claims as the language is not in proper idiomatic English. Objections to the Specification are maintained as detailed above.

27. Additionally, amended claims 1-15 are rejected under 35 U.S.C. 112 as the Specification is not adequate in supporting the subject matter set forth by the limitations.

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Furthermore, the claims as presented contain insufficient antecedent basis for many of the terms used throughout and it is unclear as to what Applicant is claiming as the invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Deering et al. ("Internet Protocol, Version 6 (IPv6) Specification", RFC 2460, 1998)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

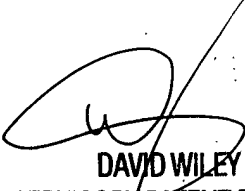
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JM



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2101